

**Response Under 37 C.F.R. § 1.116  
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REMARKS

A. Background

Claims 1, 4-9, and 11-13 were pending in the application at the time of the Office Action. The Office Action rejected claims 1, 4-9, and 11-13 as being obvious over cited prior art. By this response applicant has amended claims 1 and 9. As such, claims 1, 4-9, and 11-13 are presented for the Examiner's consideration in light of the following remarks.

B. Proposed Claim Amendments

By this response applicant has amended claims 1 and 9 to more clearly convey that the address server retrieves information from a content provider over the internet in direct response to a request from the mobile station. This limitation was already in the cited claims; language was simply added to make this limitation clearer. Accordingly, Applicant submits that because the claim amendments are supported by prior pending claim language, no new matter has been introduced nor any new issues raised which would require a further search. As such, entry of the amendments is respectfully requested.

C. Rejection on the Merits

The Office Action rejected claims 1, 4-9, and 11-13 under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,047,327 to Tso et al. in view of U.S. Patent Application No. 2001/0032254 by Hawkins. Specifically, the Office Action asserts that the Tso patent discloses the claimed invention except that Tso "does not explicitly disclose using the identifier as an argument to the URI when accessing the address server," and that Tso "does not explicitly disclose using said

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address data associated with the identifier at said address server to access said information server over the internet such that said information is provided from said information server to said mobile station via said address server." The Office Action then asserts that it would have been obvious to do these actions in view of the Hawkins reference. Applicant respectfully traverses this rejection.

The Tso patent discloses a server/client system and methods for distributing information from content providers to the client. As part of this system, the Tso patent allows information on the internet to be identified and to be received by the client using a server content database 51 and a server resource database 55 residing on an infocast server, as shown in Figure 3 of Tso.

Data received from the content providers are stored in the server content database 51, and pointers (i.e., URLs) to the content providers providing the data are stored in the server resource database 55. Col. 5, lines 48-53; col. 6, lines 5-8. This is accomplished using infocasts. Col. 7, lines 16-18. Not all information received from the content providers is stored in server content database 51, only those "resources that are often used to reduce accessing time but yet of a relatively small size to conserve space. Larger resources will not be contained in server content database 51 and will be accessed through the use of server resource database 55." Col. 5, lines 48-53. "Through the use of server resource database 55, the resources which are not located locally can be accessed through the use of the URLs contained in server resource database 55." Col. 6, lines 17-20.

For each infocast, an infobite containing summary information about what is in the infocast is generated by the infocast server and sent to the client. Col. 7, lines 30-40. If the client wants more information on any story summarized in the received infobite, the client sends a message back to the infocast server requesting that the infocast server send the URL associated with the story's content provider back to the client. Col. 8, lines 48-53. In response, the infocast server sends to the client

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either the URL stored in server resource database 55 or, "bandwidth permitting," the story stored in server content database 51. Col. 8, lines 54-57; *see also* col. 24, line 60-col. 25 line 2. If the server sends the URI, the *client* then uses the URL to retrieve the resource information from the internet site directly using a back channel interface 81, bypassing the server. Col. 14, lines 29-32; col. 25, lines 20-23; Fig. 3. If, on the other hand, the server sends the story, Tso discloses only that the infocast server sends stories that the infocast server has previously stored in the server content database 51. Col. 14, lines 21-34; col. 24, lines 60-66. As acknowledged by the Office Action, Tso does not disclose the server accessing or retrieving any information from an internet site in direct response to any request from the client.

To summarize, if the client requests further information regarding an infobite previously sent by the infocast server, the infocast server will either: (1) send information already stored at the infocast server, or (2) instruct the client to directly access the content provider using a back channel that bypasses the infocast server. The infocast server does not, however, access the content provider and provide information from the content provider to the client in response to the client request.

In view of the foregoing, the Tso server does not act as an address server which uses address data associated with an identifier received from a mobile station to provide information to the mobile station by "access[ing] [an] information server over the internet in response to said mobile station accessing said address server, said information being provided from said information server to said mobile station via said address server," as recited in claim 1, or use the address data "to access said information at said information server over the internet in response to receiving said identifier from said mobile station; and transfer ... said information accessed at said information server to said mobile station," as recited in claim 9. Likewise, the Tso patent does not

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disclose or suggest an arrangement at a mobile station for accessing information stored at an information server, the arrangement comprising means for "receiving said information from said address server over said Internet protocol and said data communication bearer service, said information having been retrieved by the address server from the information server over the internet in response to the address server being accessed by the mobile station," as recited in claim 12. The above points are conceded in the Office Action which states that "Tso does not explicitly disclose using said address data associated with the identifier at said address server to access said information server over the internet such that said information is provided from said information server to said mobile station via said address server." Office Action, p. 3.

The Office Action asserts that Hawkins discloses "using an identifier associated with address data stored in a proxy server", and using the identifier as an argument of a URL "such that the address data associated with the identifier can be used by the proxy server to retrieve the information over the internet and subsequently provide it to the mobile station via the proxy server." Office Action, p. 4. The Office Action further asserts that it would be obvious to combine the teachings of Hawkins with Tso to generate the claimed invention. Applicant respectfully traverses this rejection.

"To establish a *prima facie* case of obviousness ... there must be some suggestion or motivation . . . to combine reference teachings." MPEP § 2143. In determining if there is motivation to combine references, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01. Applicant submits that it would not be obvious to modify the disclosure of the Tso patent based on the teachings of Hawkins because such a modification is contrary to the intended purpose, function and operation of the Tso patent.

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The Tso patent states that small, often used data files are stored on server content database 51 to "reduce access time." Col. 5, lines 49. The Tso patent, however, also emphasizes the importance of saving bandwidth. For example, the Tso patent states that "[r]esource identifiers are especially useful in low-bandwidth implementations – such as the short message services provided by a cellular telephone network, e.g., network B 21, or a two-way paging system – as bandwidth is saved by transmitting only a small bit pattern resource identifier instead of a fully qualified URL for a resource or the resource itself." Col. 8, lines 5-10. It is inherent from the teachings of Tso that the reason why all data files that are not already stored on the infocast server must be obtained by the client directly accessing the content provider using a back channel that bypasses the infocast server is to maximize the conservation of bandwidth. That is, the Tso patent specifically discloses a system wherein small, frequently used data files can be quickly accessed because they are stored on the infocast server and because they only require minimal bandwidth. In turn, larger data files that would require significant bandwidth for the infocast server to transmit to the client are required under the Tso patent to be accessed directly by the client by bypassing the infocast server. As a result, the infocast server can concurrently service multiple clients while ensuring that one or more select clients do not overly monopolize bandwidth and thereby reduce access time for all clients and/or create other bandwidth problems. Under this system, the infocast server of the Tso patent never accesses a content provider over the internet in response to a client request.

In contrast, the section of the Hawkins patent cited by the Office Action discloses that in response to every request from a client, the corresponding server retrieves data from a web site and transmit the data directly back to the client. As discussed above, the Office Action asserts that it would be obvious to modify the teachings of the Tso patent based on the teachings in the Hawkins.

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Applicant respectfully disagrees. Based on the teachings in Hawkins, such a modification would require that in every request received by the infocast server from a client, the infocast server would be required to retrieve data directly from the web site and transmit it back to the client. Applicant respectfully submits that there is no motivation to make such a modification since such a modification would destroy the intended function, purpose, and operation of the Tso patent. Specifically, such a modification would enable one or more select clients to occupy substantial amounts of bandwidth and thereby decrease access time for all clients and/or potentially create other bandwidth problems. Furthermore, such a modification would destroy the intended operation of the Tso patent in that it would eliminate use of the back channel interface and storing information on the infocast server.

In view of the foregoing, applicant respectfully submits that there is no motivation to modify the teachings of the Tso patent based on the teaching of the Hawkins patent. As such, applicant respectfully requests that the obviousness rejection with respect to claims 1, 9, and 12 be withdrawn. Claims 4-8, 11, and 13 depend from claims 1, 9, or 12 and thus incorporate the limitations thereof. As such, applicant submits that claims 4-8, 11, and 13 are distinguished over the cited prior art for at least the same reasons as discussed above with regard to claims 1, 9, and 12. Accordingly, Applicant respectfully requests that the obviousness rejection with respect to claims 4-8, 11, and 13 also be withdrawn.

No other objections or rejections are set forth in the Office Action.

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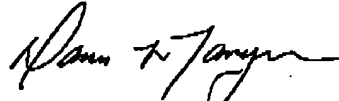
**D. Conclusion**

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited prior art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 1, 4-9, and 11-13 as amended and presented herein. In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 27<sup>th</sup> day of September 2005.

Respectfully submitted,



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